

## REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 15, 2006 (hereinafter Office Action) have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully requests withdrawal of the finality of the rejections presented in the instant Office Action dated August 15, 2006 because final rejection is improper and premature. The MPEP states that: “A second or subsequent action on the merits of any application. . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.” *See*, MPEP §706.07(a) (emphasis added). In the previous response, Applicant amended independent Claims 1 and 15 to include limitations directed to establishing a virtual identifier in at least one of a first user equipment and a service network. Original Claims 4 and 17 were directed to establishing a virtual identifier in the service network, and original Claim 7 was directed to “establishing the virtual identifier in the first user equipment.” The claim amendments made in the previous response should reasonably have been expected to be claimed because they were claimed in dependent claims. In addition, these limitations should have been included in the Examiner’s original search because they were recited in original Claims 4, 7 and 17. Further, additional Claims 21-36 largely correspond to the limitations of original Claims 1-20, and also would not have necessitated the new grounds of rejection, as evidenced, for example, by the Examiner’s repetition of the rationale and citations used in the rejection of Claim 1 in the rejection of Claim 21. For at least these reasons, final rejection is both improper and premature and must be withdrawn in accordance with MPEP §706.07(c-d).

Applicant has canceled Claims 24-29, without prejudice, rendering any rejection of these claims moot. Applicant respectfully requests that such rejections be withdrawn.

Applicant respectfully traverses each of the §103(a) rejections based at least in part on an asserted combination of U.S. Publication No. 2001/0029496 by Otto *et al.* (hereinafter “Otto”) in view of U.S. Publication No. 2005/0132065 by Zhou (hereinafter “Zhou”) because the asserted teachings, alone or in combination, do not correspond to the

claimed invention. The Examiner acknowledges that Otto fails to teach linking a virtual identifier of a first user equipment to a first characteristic of the first user equipment. In an attempt to overcome this deficiency, the Examiner asserts that Zhou teaches such limitations in mapping a virtual domain name (asserted as corresponding to the claimed characteristic identifier) to a virtual IP address (asserted as corresponding to the claimed virtual identifier). However, the Examiner's reliance on these teachings of Zhou is misplaced as Zhou's virtual IP address and virtual domain name do not correspond to the claimed virtual identifier and characteristic identifier of a first user equipment. The virtual domain name and virtual IP address of Zhou relate to a virtual computing device (VCD) which corresponds to a virtual domain 440 (lines 2-3 of paragraph [0032]). However the VCDs of Zhou are not actual physical devices (paragraph [0016]) and therefore do not correspond to the claimed first user equipment. The virtual IP address of Zhou refers to an IP address for a "virtual device" and is not a "virtual identifier" for an actual device as in the claimed invention. Thus, the virtual domain name and virtual IP address of Zhou do not correspond to the claimed virtual identifier and characteristic identifier for a first user equipment, as claimed. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejections are improper.

Moreover, the Examiner has not shown how Zhou's "mapping" corresponds to the claimed "linking." The cited paragraph [0032] describes storage in a virtual domain hosting computer system. The "mapping" discussed merely identifies that when a message is sent using a virtual domain name, the message is sent using the virtual IP address that is mapped thereto. In contrast, the instant Specification teaches that linking a virtual identifier to a characteristic identifier results in the virtual identifier (and not the characteristic identifier) being used to establish connections such that a second user equipment only receives information about the virtual identifier instead of the characteristic identifier. *See*, paragraph [0026]. Zhou's "mapping" does not correspond to the asserted claim limitations. As neither Zhou nor Otto teaches such limitations, any combination of these references must also fail to teach such limitations. Thus, the asserted combination does not correspond

to each of the claimed limitations and the rejections are improper. Applicant accordingly requests that each of the rejections be withdrawn.

With particular respect to dependent Claim 6 and independent Claim 34, Applicant notes that these claims are not included in any of the statements of rejection. MPEP §707.07(d) indicates that where a claim is refused the word “reject” must be used and the statutory basis for any ground of rejection should be designated by an express reference in the opening sentence of each ground of rejection. While it appears that the Examiner intended to reject Claims 6 and 34 upon the same basis of the rejection of Claims 1-3, 5, 8, 10, 14-16, 18-22, 24-26 and 29-31, such a rejection would be improper for the reasons discussed above in connection with the failure of the asserted combination of Otto and Zhou to correspond to the claimed invention. If this was not the Examiner’s intention, Applicant requests clarification, an opportunity to respond, and that any future rejections comply with MPEP §707.07(d).

Dependent Claims 2, 3, 5, 8, 10, 14, 16, 18-20 and 22 depend from independent Claims 1, 15 and 21, respectively. Each of these dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Otto and Zhou. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 15, and 21. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 3, 5, 8, 10, 14, 16, 18-20 and 22 are also allowable over the combination of Otto and Zhou.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to

combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the references is to “provide means for legitimate computing devices to obtain virtual identifiers without triggering security measures employed by other computing devices.” This is not evidence of motivation to combine the teachings of Zhou with the teachings of Otto but rather, is a generalized statement of what is asserted as being taught by Zhou. No evidence has been provided that a skilled artisan would have attempted to introduce the asserted mapping of Zhou to the teachings of Otto.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

*In re Dembicza*k, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation

is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

With respect to the §103(a) rejections based further upon the teachings of WO 00/12364 to Lumme *et al.* (hereinafter “Lumme”) and U.S. Patent No. 6,968,385 to Gilbert (hereinafter “Gilbert”), respectively, Applicant traverses because the Examiner’s reliance upon these teachings does not overcome the above-discussed deficiencies in the asserted combination of Otto and Zhou. No teachings have been cited in either Lumme or Gilbert that correspond to the claimed linking of a virtual identifier with a characteristic identifier, as claimed. Thus, without a presentation of correspondence to each of the claimed limitations, these §103(a) rejections are also improper and should be withdrawn.

Applicant has amended the pending claims to address the format of the claim language and not for reasons related to patentability. These changes should not affect the scope of the claims or introduce any new matter. The claims are believed to be patentable for the reasons discussed above.

It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.055PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

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By: Erin M. Nichols

Erin M. Nichols  
Reg. No. 57,125